

REMARKS

This is in response to the Office Action mailed on May 15, 2006. The Office Action rejected claims 23-36. Applicant has amended claim 34. The present application currently includes claims 23-36.

The Office Action objected to the claiming of the benefit of prior-filed non-provisional application no. 09/654,400 stating that co-pendency between the current application and the prior application is not found. Applicant has amended the priority claim to not include the claim of priority of U.S. application no. 09/654,400 or provisional application no. 60/157,448. With the amendment to the claim of priority, Applicant believes it has correctly claimed priority in the present application.

The Office Action also objected to the specification because of the attempt to incorporate U.S. patent application no. 09/654,400 is ineffective because it did not reference a U.S. Patent No. or a U.S. Patent Application Publication. Applicant has amended the specification to incorporate by reference U.S. Patent No. 6,315,718 which is the patent that issued from application serial no. 09/654,400. Therefore, Applicant believes that the specification now properly incorporates the patent by reference.

The Office Action also objected to the drawings because reference numeral 40 points to two elements in FIG. 1. Applicant is amending FIGS. 1 and 6 and is hereby submitting replacement drawings. With the submission of the replacement drawings, Applicant believes that the objection to the drawings should be overcome.

The Office Action also objected to the specification because of informalities. Applicant has amended the specification to overcome the informalities. Therefore, Applicant respectfully requests the objection to the specification be withdrawn.

The Office Action rejected claim 34 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 34 to overcome the insufficient antecedent basis for the limitation of the claim. Therefore, Applicant respectfully requests the rejection of claim 34 be withdrawn.

The Office Action also rejected claims 23-31 on the ground of non-statutory double patenting over U.S. Patent Nos. 6,315,718 and 6,368,271. Applicant submits that it will file a terminal disclaimer once the present application is in allowable form.

The Office Action also rejected independent claim 32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,616,605 (the Wright patent) in view of U.S. Patent No. 5,902,233 (the Farley patent). The Office Action alleges that the Wright patent discloses a system of performing a surgical procedure comprising a retractor support apparatus formed by the plates 20, 30, 40, a plurality of flesh engaging retractors 16, 26 attached to the support apparatus and a bone engaging retractor 46 mounted to the support apparatus. The Office Action states that the Wright patent does not disclose that the support is supported by a surgical table.

The Office Action alleges the Farley patent discloses a table mounted surgical retractor system having a plurality of retractor blades in a field post. The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system disclosed in the Wright patent as a table mounted system, as taught by the Farley patent, in order to make the system more stable.

Applicant respectfully disagrees that the Wright patent in view of the Farley patent makes independent claim 32 obvious. There is no teaching or suggestion in either the Wright patent or the Farley patent to make the combination absent the claimed invention.

In *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit emphasized that to reject an inventor's claim for obviousness in view of a combination of prior art references, a showing of a suggestion, teaching or motivation must be "clear and particular". The mere fact that prior art can be modified does not make the modification obvious unless the prior art taught or suggested the desirability of the modification. *In re Gordon* 221 USPQ 1125 (Fed. Cir. 1984).

Absent the present invention, there is no clear and particular motivation, teaching or suggestion that would lead one of ordinary skill in the art to combine the Wright patent with the Farley patent. The Wright patent discloses that the object of the invention is to provide a retractor that conforms more readily to the anatomy of the patient. See col. 1, lines 56-57, col. 1,

line 66-col. 2, line 3, col. 5, line 66-col. 6, line 3. In contrast, the purpose of the Farley patent is to provide a surgical retractor apparatus having a retractor blade which is angularly adjustable with respect to its handle. See col. 2, line 17-39.

There is no teaching or suggestion in the Wright patent that the apparatus be mounted to a table. Rather, mounting the apparatus to the table would be in direct conflict with the stated purpose of conforming the apparatus to the anatomy of the patient. Further, there is no disclosure in the Farley patent of mounting a bone retractor to a retractor support.

The system defined in claim 32 relates to performing a surgical procedure on a joint where one of the retractors mounted to the surgical apparatus engages and dislocates a bone from the joint. This purpose is distinctly different from the purpose stated in the Wright patent, namely conforming the retractor support to the patient's anatomy and also the Farley patent which discloses a blade for a retractor that angularly adjusts with respect to the handle. See *In re Clay*, 966 F.2d, 656, 659-660 (Fed. Cir. 1992)(a reference that discloses the same purpose of the claimed invention relates to the same problem and that fact supports use of the reference in an obviousness rejection). Therefore, the combination of the Wright patent with the Farley patent is improper.

Therefore, there is no teaching, suggestion or motivation to combine the Wright patent with the Farley patent to allege that claim 32 is obvious. Applicant believes that claim 32 is in allowable form. Reconsideration and allowance of claim 32 are respectfully requested.

The Office Action also rejected claims 33-36. Claims 33-36 depend from independent claim 32. Because independent claim 32 is in allowable form, claims 33-36 are also in allowable form. Reconsideration and allowance of claims 33-36 are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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